

Serial No. 10/022,651

Page 7 of 13

REMARKS

This response is intended as a full and complete response to the final Office Action mailed July 13, 2005. In the Office Action, the Examiner notes that Claims 1-21 are pending, of which Claims 1-21 are rejected. By this response, all claims continue unamended.

In view of the following discussion, Applicants submit that none of the claims now pending in the application are anticipated or obvious under the provisions of 35 U.S.C. §§102 and 103. Further, Applicants believe that all of the claims are directed to statutory subject matter pursuant to 35 U.S.C. §101. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant response.

35 U.S.C. §101 Rejection of Claims 1-20

The Examiner has rejected claims 1-20 as non-statutory subject matter. Applicants respectfully traverse the rejection.

Concerning claims 1-20, the Examiner alleges (emphasis added below):

"Claims 1-20 are rejected under 35 U.S.C. 101 as non-statutory subject matter because claims 1-20 is directed to a nonfunctional descriptive material, i.e., a data structure stored on computer-readable medium, and the data structure operative to provide a link ... is not-statutory. Since no requisite functionality is present to satisfy the practical application requirement.

Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory." (page 2 of the 7/13/05 Office Action)

Thus, the Examiner alleges that claims 1-20 are directed to nonfunctional descriptive material. However, the Applicant respectfully disagrees.

MPEP 2106.IV.B.1 recites (emphasis added below):

"Descriptive material can be characterized as either 'functional descriptive material' or 'nonfunctional descriptive material.' In this context, 'functional

Serial No. 10/022,651

Page 8 of 13

descriptive material' consists of data structures and computer programs which impart functionality when employed as a computer component."

MPEP 2106.IV.B.1 further recites (emphasis added below):

"When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized."

Thus, statutory subject matter includes data structures which are (i) recorded on a computer readable medium, and (ii) are functional descriptive material that impart functionality when employed or realized by a computer component or other technology.

Applicants' Claim 1 recites (emphasis added below):

"1. A data structure stored on computer readable media, the data structure comprising:

one or more data tags, each data tag used to provide information regarding a broadcast advertisement;

one or more electronic program guide action tags, each electronic program guide action tag used to define a valid electronic program guide feature that may be accessed from within the broadcast advertisement, the electronic program guide feature being related to the broadcast advertisement, a program associated with the broadcast advertisement, or both;

the data structure operative to provide a link between the broadcast advertisement and an electronic program guide to provide access to electronic program guide features defined by the electronic program guide action tags from within the broadcast advertisement."

Thus, the claim language clearly recites a data structure stored on a computer readable media as discussed in (i) above. Furthermore, the data structure is functional descriptive material as discussed in (ii) above. The claim language clearly recites that the data structure is operative to provide a link between the broadcast advertisement and an electronic program guide. This is functional because such a link provides access to electronic program guide features from the broadcast advertisement. Such EPG features are defined in the Specification as follows:

"EPG actions include, but are not limited to tuning the set top terminal to a channel to watch a program being advertised, creating a reminder in an electronic program guide for a program airing in the future, purchasing a

Serial No. 10/022,651

Page 9 of 13

PPV event, storing the advertisement, and accessing related on-line content." (page 9, lines 8-11)

Thus, the EPG features are defined by the examples given above to be concrete and tangible actions involving the EPG.

Therefore, because claim 1 has a computer-readable medium having a data structure which includes functional descriptive material, claim 1 is directed to statutory subject matter as defined in MPEP 2106.IV.B.1. Moreover, claims 2-20 depend, directly or indirectly, from independent claim 1, and as such inherent all the limitations recited in claim 1. Thus, claims 2-20 are also directed to statutory subject matter.

35 U.S.C. §102 Rejection of Claims 1-5, 9-21

The Examiner has rejected claims 1-5 and 9-21 under 35 U.S.C. §102(e) as being unpatentable by Fries (US 6317885, hereinafter "Fries"). Applicants respectfully traverse the rejection.

Applicants' independent claim 1 recites (emphasis added below):

- "1. A data structure stored on computer readable media, the data structure comprising:
one or more data tags, each data tag used to provide information regarding a broadcast advertisement;
one or more electronic program guide action tags, each electronic program guide action tag used to define a valid electronic program guide feature that may be accessed from within the broadcast advertisement, the electronic program guide feature being related to the broadcast advertisement, a program associated with the broadcast advertisement, or both;
the data structure operative to provide a link between the broadcast advertisement and an electronic program guide to provide access to electronic program guide features defined by the electronic program guide action tags from within the broadcast advertisement."

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Fries reference fails to disclose each and every element of the claimed invention, as arranged in claim 1.

Serial No. 10/022,651

Page 10 of 13

Specifically, the Fries reference fails to disclose at least the "one or more data tags, each data tag used to provide information regarding a broadcast advertisement" and the "one or more electronic program guide action tags ... used to define a valid electronic program guide feature ... being related to the broadcast advertisement, a program associated with the broadcast advertisement, or both."

The Fries reference discloses an "interactive entertainment and information system using a television set-top box, wherein pages of information are periodically provided to the set-top box for user interaction therewith" (abstract). In particular, regarding the claimed "one or more data tags, each data tag used to provide information regarding a broadcast advertisement", the Examiner cites the following portion of the Fries reference (emphasis added below):

"In another scenario, the user is watching programming on a specific channel that participates in the Information Service. If the user pushes the "A" button 104 on the remote control 76 (FIG. 4) at any time while viewing such a participating channel, as detected by step 500, an initial page image (the "top-level" page) corresponding to that channel is displayed (step 520), along with links to other pages. For example, (assuming station participation), a user viewing ESPN will be shown an ESPN top-level page when the "A" button 104 is pressed. As before, if the top-level page provides links, the user can select from among those links and jump to other pages from that top-level page, but in this scenario those links ordinarily connect to only a small number of pages that are recognized as being "tied" to the original video channel. The user can exit the service by changing to another channel (step 518), or by again pushing the "A" button 104 (step 514). Note that in this scenario, step 516 does not display the home page when the "A" button is detected, but instead branches to step 522 where the set-top box is returned to the previous channel and the service is exited." (column 7, lines 34-53)

Thus, the Fries reference discloses that a page image is displayed, upon the user pushing a button, that corresponds to the channel the user is viewing at the time the button is pushed. Furthermore, the links present on the displayed page ordinarily connect to pages which are tied to the channel the user was watching. However, the Fries reference does not disclose "one or more data tags, each data tag used to provide information regarding a broadcast advertisement". That is, the Fries reference does disclose displaying a page image which corresponds to an advertisement that is being

Serial No. 10/022,651

Page 11 of 13

broadcast. Instead, the Fries reference only displays a page image which corresponds to a channel.

Furthermore, the Fries reference also fails to disclose the "one or more electronic program guide action tags ... used to define a valid electronic program guide feature ... being related to the broadcast advertisement, a program associated with the broadcast advertisement, or both." As discussed above, the Fries reference only discloses displaying a page which corresponds to a channel, the page having links that are "tied" to the channel. By contrast, the claim 1 recites a data structure including EPG action tags defining EPG features which are related to the broadcast advertisement or a program associated with the advertisement. The Examiner additionally cites column 18, lines 8-23, as allegedly disclosing the EPG action tags as recited in the claim, however this cited portion of the Fries reference does not contain a disclosure of an EPG action tag related to the advertisement.

Thus, the Fries reference fails to disclose each and every element of the claimed invention, as arranged in claim 1.

As such, Applicants submit that independent claim 1 is not anticipated and fully satisfies the requirements of 35 U.S.C. §102 and is patentable thereunder. Moreover, claim 21 contains substantially similar relevant limitations as those discussed above in regards to claim 1, and thus is also patentable under 35 U.S.C. §102. Furthermore, claims 2-5 and 9-20 depend, either directly or indirectly, from independent claims 1 and 21 and recite additional features thereof. As such and at least for the same reasons as discussed above, Applicants submit that these dependent claims are also not anticipated and fully satisfy the requirements of 35 U.S.C. §102 and are patentable thereunder. Therefore, Applicants respectfully request that the Examiner's rejection be withdrawn.

35 U.S.C. §103(a) Rejection of Claims 6-8

The Examiner has rejected claims 6-8 under 35 U.S.C. §103(a) as being unpatentable over Fries in view of Lawler et al. (US 5805763, hereinafter "Lawler"). Applicants respectfully traverse the rejection.

Serial No. 10/022,651

Page 12 of 13

Claims 6, 7 and 8 depend, directly or indirectly, from independent Claim 1 and recite additional limitations thereof. Claim 1 is patentable at least for reasons given above. As such and at least for the same reasons as discussed above, these dependent claims are also patentable under 35 U.S.C. §103.

390747_1.DOC

Serial No. 10/022,651

Page 13 of 13

CONCLUSION

Thus, Applicants submit that none of the claims presently in the application are anticipated or obvious under the respective provisions of 35 U.S.C. §102 and §103.

Further, Applicants submit that the pending claims are directed to statutory subject matter. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Eamon J. Wall or Stephen Guzzi at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 9/6/05



Eamon J. Wall
Registration No. 39,414
Attorney for Applicants

MOSER, PATTERSON & SHERIDAN, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-530-9404
Facsimile: 732-530-9808

390747_1.DOC